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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/913,464	08/15/2001	Loic Ollivier	Q65563	2414

23373 7590 03/10/2005

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EXAMINER

UBILES, MARIE C

ART UNIT	PAPER NUMBER
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2642

DATE MAILED: 03/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	09/913,464		OLLIVIER ET AL.	
	<b>Examiner</b>		<b>Art Unit</b>	
	Marie C. Ubiles		2642	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 November 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

1. Applicant's Appeal Brief filed on November 22, 2004 has been entered. Claims 1-6 are still pending in this application, with claims 1, 5 and 6 being independent.

### ***Response to Arguments***

2. In view of the Appeal Brief filed on 11/22/2004, PROSECUTION IS HEREBY REOPENED. A new ground of rejection set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

### ***Claim Rejections - 35 USC § 112***

3. Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "receives them" in line 3. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 103***

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Foladare et al. (US 5,982,774).

As for claim 1, Foladare et al. a method of transmitting information (or "call waiting service" message) to a telephone subscriber terminal (or terminal 101) from a local exchange (or LEC 103 and IAP 104) of a telephone network to which the telephone subscriber terminal unit is connected via at least one analog telephone line (or telephone line 105), the method comprising; generating and encoding command or information messages (or new page, new window with waiting call message; See Col. 3, lines 30-35) at the local exchange (See Col. 3, lines 15-35); receiving the command or information messages at the telephone subscriber terminal unit (or terminal 101) and decoding and interpreting the command or information messages in information processing means of the telephone subscriber terminal unit in order to display the command or information messages as text messages (i.e. "over-write") at the telephone subscriber terminal unit (See Col. 3, lines 30-35).

Further, Foladare et al. discloses "transmitting the command or information messages from the local exchange to the telephone subscriber terminal unit in addition

to sending [...] telephone signaling via the analog telephone line" (as read on "after receiving a ringing signal...")(See Col. 3, lines 40-51).

Regarding the part of the limitation reciting "in addition to sending speech signals...", it would have been obvious that after accepting the communication the called party (at the telephone terminal subscriber unit) a speech signal (i.e. a conversation) will be transmitted from the local exchange terminal, in addition to the information message, via the analog telephone line (See Col. 3, lines 48-51).

Claim 2 limitation reciting "...in response to a request from the telephone subscriber terminal unit" reads for example on a user subscribing to the "Internet on Hold Waiting Service" (See Col. 2, lines 52-54). If the user subscribes herself or himself by using terminal 101 or telephone set 111, the user is in fact requesting a service from him or her telephone subscriber terminal.

As for claim 3, the limitation claiming "wherein the command or information messages are messages whose content is intended to be at least temporarily stored at the telephone terminal subscriber unit that receives them", reads for example in the implicit ROM functions that terminal 101 performs when receiving a "new window, new page or over-write".

As for claim 4, the limitation "wherein the command or information messages are command transmission messages" is taught by Foladare in the user clicking on an 'accept' icon (See Col. 3, lines 39-40).

Art Unit: 2642

Claims 5-6 are rejected for the same reasons as claim 1. The limitation reciting "management logic unit" read on the functions performed to display a new page, a new window or an over write-in in terminal 101 (See Col. 1, lines 30-35).

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Creamer et al. (US 6,028,917) teaches a system and method that provides access to extended telephone services via the internet.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marie C. Ubiles whose telephone number is (703) 305-0684. The examiner can normally be reached on 8am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad Matar can be reached on (703) 305-4731. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2642

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Marie C. Ubiles  
March 3, 2005.

  
JACK CHIANG  
PRIMARY EXAMINER